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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,076	08/20/2003	Ulrich Luecking	SCH-1929	4728

23599 7590 12/28/2006  
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EXAMINER
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COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/644,076

Applicant(s)

LUECKING ET AL.

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9-12,14,17 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 6,10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9,12,14 and 17 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1, 3-6, 9-12, 14, 17 and 24 are pending in the application.

This action is in response to applicants' amendment dated October 20, 2006.

Claims 1, 3-6, 10-12, 14 and 17 have been amended, claims 2, 7, 8, 13 and 18-22 have been canceled and claim 24 is newly added.

### ***Response to Arguments***

Applicant's arguments filed October 20, 2006 have been fully considered with the following effect:

1. With regards to the 35 U.S.C. § 112, first paragraph rejection labeled paragraph 1) maintained in the last office action, the applicant's arguments have been fully considered, however they were not found persuasive. The applicant's stated that the claims have been amended so as to be particularly directed to the indications recited in claim 13 in part and that it is thus respectfully submitted that this rejection is also moot. However, the scope of claim 13 was also included in the rejection and thus a limit to the scope of claim 13 is not sufficient to overcome this rejection. Specifically, claim 12 as amended is to the method of treatment of any and all cancers via solid tumors, tumor or metastasis growth.

In evaluating the enablement question, several factors are to be considered. In *re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988); *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5)

Art Unit: 1624

the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

Where the utility is unusual or difficult to treat or speculative, the examiner has authority to require evidence that tests relied upon are reasonably predictive of in vivo efficacy by those skilled in the art. See *In re Ruskin*, 148 USPQ 221; *Ex parte Jovanovics*, 211 USPQ 907; MPEP 2164.05(a).

Patent Protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. Tossing out the mere germ of an idea does not constitute enabling disclosure. *Genentech Inc. v. Novo Nordisk* 42 USPQ2d 1001.

As stated in the MPEP, 2164.08 "[t]he Federal Circuit has repeatedly held that the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1561 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Nevertheless, not everything necessary to practice the invention need be disclosed. In fact, what is well known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a reasonable correlation to the scope of the claims. See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). As concerns the breadth of a claim relevant to enablement, the only relevant concern should be whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with

Art Unit: 1624

the scope of protection sought by the claims. In re Moore, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971). See also Plant Genetic Sys., N.V. v. DeKalb Genetics Corp., 315 F.3d 1335, 1339, 65 USPQ2d 1452, 1455 (Fed. Cir. 2003) (alleged pioneer status of invention irrelevant to enablement determination."

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for reasons of record and stated above.

2. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 2b), c), d), e), f), h), i) and s) maintained in the last office action, which are hereby **withdrawn**.

3. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection labeled paragraph 5) of the last office action, which is hereby **withdrawn**.

4. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 6a), b), c), d) and e) of the last office action, which are hereby **withdrawn**.

In view of the amendment dated October 20, 2006, the following new grounds of rejection apply:

***Election/Restrictions***

5. Claims 6, 10 and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 30, 2005.

6. This application contains subject matter in claims 1, 3 and 24 drawn to an invention nonelected with traverse in Paper filed November 30, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 1, 3-5, 9, 12, 14 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1, 9, 12 and 14 are vague and indefinite in that it is not known what is meant by the moieties C<sub>1</sub>-C<sub>10</sub>-alkylene, C<sub>2</sub>-C<sub>10</sub>-alkenylene, C<sub>2</sub>-C<sub>10</sub>-alkynylene or C<sub>3</sub>-C<sub>10</sub>-cycloalkylene in the definition of R<sup>1</sup> and R<sup>5</sup>, which are divalent moieties and the variables R<sup>1</sup> and R<sup>5</sup> are monovalent.
- b) Claims 3-5 and 17 are vague and indefinite in that it is not known what is meant by the variable n, which is not defined within the claim.

***Claim Objections***

8. Claim 24 is objected to because of the following informalities: presence of non-elected subject matter with respect to the definition of A. Appropriate correction is required.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

Art Unit: 1624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brenda L. Coleman  
Primary Examiner Art Unit 1624  
December 23, 2006